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WASHINGTON DC 20007

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FEB 17 2009

In re Application of : **OFFICE OF PETITIONS**
Fujii et al. :
Application No. 10/718,543 : ON APPLICATION FOR
Filed: November 24, 2003 : PATENT TERM ADJUSTMENT
Atty Docket No. 086142-0600 :

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d) filed September 9, 2008. Applicant requests that the determination of patent term adjustment be corrected from two hundred (200) days three hundred twenty-one (321) days. Applicant requests this correction in part on the basis that the Office will take in excess of three years (3 years and 4 days) to issue this patent.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b). (This is true even in this instance where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.703(b) calculation until the actual date of issuance of the patent has been determined. Accordingly, it is still too soon to make a determination as to the correctness of any period of adjustment that will or will not be entered pursuant to § 1.703(b)).

Applicant is given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent

within 3 years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

It is acknowledged that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including –

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is noted that a Request for Continued Examination (RCE) was filed in this application on October 31, 2007.

To the extent that applicant otherwise requests correction of the patent term adjustment at the time of mailing of the notice of allowance, the application for patent term adjustment is **GRANTED**.

The Office has updated the PALM screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time

of the mailing of the notice of allowance is three hundred seventeen (317) days. A copy of the updated PALM screen, showing the correct determination, is enclosed.

On August 8, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 200 days. On September 9, 2008, applicant timely submitted the instant application for patent term adjustment¹. Applicant disputes the reduction of 145 days associated with their delay in filing a reply in compliance with 1.113(c) to the final Office action mailed March 8, 2007. Applicant states that this period should have been calculated as 28 days based on their filing of a Notice of Appeal on July 6, 2007, and not as 145 days based on their filing of a request for continued examination (RCE) on October 31, 2007.

The record supports a conclusion that this application is not subject to a terminal disclaimer.

Applicant's arguments have been considered and found persuasive. A review of the record reveals that the Notice of Appeal was re-submitted on September 5, 2007, with a date-stamped postcard evidencing its original filing in the Office on July 6, 2007. As such, with respect to the final Office action mailed March 8, 2007, the period of applicant delay within the meaning of 37 CFR 1.704(b) is properly calculated using the date of filing of the notice of appeal, July 6, 2007. July 6, 2007 is three months and 28 days after March 8, 2007. The period of reduction of 145 days is being removed and the period of reduction of 28 days is being entered.

It is further noted that the filing of the request for continued examination (RCE) on October 31, 2007 does not constitute applicant delay. (As previously stated, its filing does cut off the period for calculating the over 3 year Office delay).

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance is 317 days (345 days of Office delay reduced by 28 days of applicant delay).

¹ PALM records indicate that the issue fee was also paid on September 9, 2008.

Receipt of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent will include any additional patent term adjustment accrued for Office delay in issuing the patent after payment of the issue fee and all outstanding requirements having been met.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a large, stylized initial "N" and a long, sweeping underline.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PALM Screen

PALM INTRANET

Time: 21:06:16

PTA Calculations for Application: 10/718543			
Application Filing Date:	11/24/2003	PTO Delay (PTO):	345
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	145
Post-Issue Petitions:	0	Total PTA (days):	317
PTO Delay Adjustment:	117		

File Contents History					
Number	Date	Contents Description	PTO	APPL	START
70	02/14/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		28	
69	02/14/2009	ADJUSTMENT OF PTA CALCULATION BY PTO	145		
60	08/08/2008	MAIL NOTICE OF ALLOWANCE	8		54
59	08/06/2008	ISSUE REVISION COMPLETED			
58	08/06/2008	DOCUMENT VERIFICATION			
57	08/06/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
56	08/04/2008	NOTICE OF ALLOWABILITY			
55	05/21/2008	DATE FORWARDED TO EXAMINER			
54	03/31/2008	RESPONSE AFTER NON-FINAL ACTION			
53	01/08/2008	MAIL NON-FINAL REJECTION			
52	01/04/2008	NON-FINAL REJECTION			
51	11/14/2007	MISCELLANEOUS INCOMING LETTER			
50	11/08/2007	DATE FORWARDED TO EXAMINER			
49	10/31/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
48	11/08/2007	DATE FORWARDED TO EXAMINER			
47	10/31/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)		145	36
46	11/08/2007	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
45	11/06/2007	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
44	10/31/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
42	09/04/2007	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
41	09/05/2007	MISCELLANEOUS INCOMING LETTER			
40	06/25/2007	MAIL ADVISORY ACTION (PTOL - 303)			

39	06/21/2007	ADVISORY ACTION (PTOL-303)			
38	06/19/2007	DATE FORWARDED TO EXAMINER			
37	06/07/2007	AMENDMENT AFTER FINAL REJECTION			
36	03/08/2007	MAIL FINAL REJECTION (PTOL - 326)			
35	03/05/2007	FINAL REJECTION			
34	11/21/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
33	12/30/2006	DATE FORWARDED TO EXAMINER			
32	12/11/2006	RESPONSE AFTER NON-FINAL ACTION			
31	11/21/2006	REFERENCE CAPTURE ON IDS			
30.7	11/21/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
30	11/21/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
29	09/11/2006	MAIL NON-FINAL REJECTION			
28	09/05/2006	NON-FINAL REJECTION			
27	06/30/2006	DATE FORWARDED TO EXAMINER			
26	06/22/2006	RESPONSE AFTER NON-FINAL ACTION			
25	06/22/2006	INCOMING LETTER PERTAINING TO THE DRAWINGS			
24	03/22/2006	MAIL NON-FINAL REJECTION			
23	03/20/2006	NON-FINAL REJECTION			
22	06/14/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
21	11/24/2003	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
20	02/03/2006	DATE FORWARDED TO EXAMINER			
19	01/27/2006	RESPONSE TO ELECTION / RESTRICTION FILED			
18	12/27/2005	MAIL RESTRICTION REQUIREMENT	337		-1
17	12/22/2005	REQUIREMENT FOR RESTRICTION / ELECTION			
16	10/17/2005	CASE DOCKETED TO EXAMINER IN GAU			
15	09/10/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
14	11/24/2003	REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED)			
13	09/10/2004	CASE DOCKETED TO EXAMINER IN GAU			
12	06/14/2004	REFERENCE CAPTURE ON IDS			
11.7	06/14/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
		INFORMATION DISCLOSURE STATEMENT (IDS)			

11	06/14/2004	FILED			
10	08/25/2004	REFERENCE CAPTURE ON IDS			
9.7	11/24/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9	11/24/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
8	02/19/2004	APPLICATION RETURN FROM OIPE			
7	02/19/2004	APPLICATION RETURN TO OIPE			
6	02/19/2004	APPLICATION DISPATCHED FROM OIPE			
5	02/19/2004	APPLICATION IS NOW COMPLETE			
4	02/05/2004	CLEARED BY OIPE CSR			
3	02/05/2004	CASE CLASSIFIED BY OIPE			
2	12/24/2003	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	11/24/2003	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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